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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,610	09/14/2001	Hideki Matsushima	2001-1316A	7300

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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,610

Applicant(s)

MATSUSHIMA ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 20-35 have been withdrawn.
2. Claims 1-20 have been considered.

Election/Restrictions

3. Applicant's election without traverse of claims 1-20 in the reply filed on 26 January 25 is acknowledged.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 3, 4, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2005/00101647 to Peter Emmanuel Durham.

6. As per claims 1 and 11, Durham teaches a service providing method of providing a current user of a first apparatus with each of services that are provided by a plurality of other apparatuses via a network, the first apparatus being able to communicate with each of the plurality of other apparatuses via the network and being locally connectable to a recording medium, out of recording media that are uniquely assigned to users of the first apparatus, each recording medium being transportable and including an area for storing unique information,

the service providing method comprising:

a service requesting step where the first apparatus requests a second apparatus to provide a service desired by the current user, the second apparatus being one of the plurality of other apparatuses;

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a unique information reading step where if a recording medium of the current user is locally connected to the first apparatus and stores unique information, the second apparatus reads the unique information in the locally connected recording medium via the first apparatus and the network; and

a service providing step where the second apparatus customizes the desired service according to the read unique information and transmits the customized service to the first apparatus (See Durham paragraphs [0022], [0041, and [0051]).

7. As per claims 2 and 12, Durham teaches the service providing method of claim 1,

wherein in the unique information reading step, if no unique information is stored in the locally connected recording medium or no recording medium is locally connected to the first apparatus, the second apparatus does not read unique information from anywhere, and

in the service providing step, if no unique information has been read in the unique information reading step, the second apparatus transmits the desired service to the first apparatus in an uncustomized state (See Durham paragraphs [0026] and [0051]).

8. As per claims 3 and 13, Durham teaches the service providing method of claim 2,

wherein the unique information stored in each recording medium includes user information that is inherent in a user assigned the recording medium, and

in the service providing step, the second apparatus customizes the desired service for the current user according to the user information included in the read unique information and transmits the customized service to the first apparatus (See Durham paragraphs [0041] and [0051]).

9. As per claims 4 and 14, Durham teaches the service providing method of claim 3 further comprising:

a user information updating step, performed after the unique information reading step, where if the user information inherent in the current user needs to be updated, the second apparatus updates the user information included in the read unique information and overwrites the user information in the locally

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connected recording medium with the updated user information via the network and the first apparatus (See paragraphs [0009], [0051], and [0057]).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2005/00101647 to Peter Emmanuel Durham.

12. As per claims 7 and 17, Durham teaches the service providing method of claim 2, Durham clearly teaches the unique information stored in each recording medium includes an identifier,

the second apparatus stores user information so that user information inherent in each user is associated with the media identifier of the recording medium assigned to the user, and the service providing step includes:

a user information finding substep where the second apparatus finds user information associated with the media identifier included in the read unique information; and

a customizing substep where the second apparatus customizes the desired service for the current user according to the found user information.

What is not disclosed by the Durham reference is that the identifier includes a media identifier of the recording medium.

However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to use unique device or media identifiers (serial number) as part or sometime as only

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identifying value string for the purposes of authentication or identification of such device or media for further enhancing a verification of the user in conjunction with the device or the media or authorization.

13. As per claims 8, Durham teaches the service providing method of claim 1, further;

Durham teaches a recording medium connection step, performed before the service-requesting step, where the first apparatus is locally connected to the recording medium assigned to the current user (See Durham figure 1 and paragraph [0022]).

14. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2005/00101647 to Peter Emmanuel Durham in view of U.S. Patent No. 5,917,913 to Ynjiun Paul Wang.

15. As per claims 5 and 15, Durham teaches the service providing method of claim 4,

Durham clearly teaches the second apparatus stores a secret key corresponding to the public key, in the service providing step, the second apparatus decrypts the encrypted user information using the secret key and customizes the desired service according to the decrypted user information, and in the user information updating step, the second apparatus updates the decrypted user information, encrypts the updated user information using the public key, and overwrites the encrypted user information in the locally connected recording medium with the updated and encrypted user information.

What is not explicitly disclosed by Durham is the user information in each recording medium has been encrypted using a public key of a public key cryptosystem.

However, Wang clearly teaches the encryption of the user information and storage of public keys (See Wang figure 3A-4, column 3, lines 22-67, column 9, lines 48-56, and column 11, lines 33-62).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Wang in Durham's to achieve a better security as well as privacy of information.

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16. As per claims 6 and 16, Durham teaches the service providing method of claim 5, further; Durham clearly teaches the network is the Internet, the first apparatus is an Internet terminal that runs a specialized Internet browser, each of the plurality of other apparatuses is a Web site, the unique information stored in each recording medium includes cookie information used through the Internet browser, and each recording medium stores the cookie information as a file (See figure 2, paragraphs [0025]-[0026], [0040], and [0054]).

17. As per claims 9 and 19, Durham teaches the service providing method of claim 8, As discussed above all the steps of the claim has been addressed except the use of the password. However, Wang clearly teaches the use of password or any other authentication mechanism to be used for authentication and access to the device or the media (See Wang column 11, lines 1-13).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Wang in Durham's to achieve further enhancing of security as well as privacy of information.

18. As per claims 10 and 20, Durham teaches the service providing method of claim 9, As discussed above all the steps of the claim has been addressed except each recording medium includes a secure data area. However, Wang clearly teaches the security of the data within the PEAD device as well as need of authentication of the user before access to the data is granted (See Wang column 11, lines 1-13 and column 11, line 63-column 12, line 6). It is clear that the PEAD has a secure data storage to store the encrypted data as it is clearly shown in the description of the PEAD device.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Wang in Durham's to achieve further enhancing of security as well as privacy of information.

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Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (571) 272-6702. The examiner can normally be reached on 9 AM to 5:00 PM.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

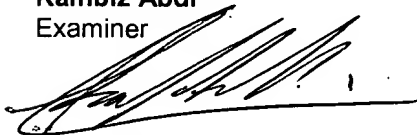
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

Kambiz Abdi
Examiner



April 18, 2005